

REMARKS

This communication is a full and timely response to the final Office Action dated July 2, 2008. Claims 5, 8, 13, and 14 remain pending, where claims 1-4, 6, 7, and 9-12 are cancelled. By this communication, claims 5, 8, and 14 are amended. Support for the amended subject matter can be found, for example, in paragraphs [0088] and [0089] of the disclosure.

Claim Objections

On page 2 of the Office Action, claim 14 is objected to for alleged informalities. Applicant has amended claim 14 in a manner that renders this objection moot. Accordingly, withdrawal of this rejection is respectfully requested.

Rejections Under 35 U.S.C. §102

On page 3 of the Office Action, claims 5, 13, and 14 are rejected under 35 U.S.C. §102(e) for alleged anticipation by *Chui* (U.S. Patent Publication No. 2002/0021758). Applicant respectfully traverses this rejection.

Contrary to the assertions made in the Office Action, the *Chui* publication fails to disclose or suggest every feature recited in Applicant's claims. In particular, claim 5 recites the following:

A file storage device that communicates with a portable terminal,
comprising:

a thumbnail image transmitting part for transmitting a thumbnail
image for a specified file to said portable terminal in response to a request
from said portable terminal;

an enlarged image generating part that is responsive to a request
from said portable terminal containing a coordinate of an enlargement

reference point of said thumbnail image and an enlarging ratio relative to said thumbnail image, for generating an enlarged image of said thumbnail image, said enlarged image corresponding to said enlargement reference point of said thumbnail image and said enlarging ratio relative to said thumbnail image; and

an enlarged image transmitting part that receives the enlarged image from the enlarged image generating part and transmits the enlarged image generated to said portable terminal.

The *Chui* publication fails to describe any features that are related or analogous to Applicant's claimed enlarged image generating part and an enlarged transmitting part.

In contrast, the *Chui* publication discloses a system in which image data is downloaded from a server or other system across a network. The images are stored in a compressed format and in a file structure that comprises a series of sub-images. Each sub-image is a predetermined portion of the size of its predecessor. For example, each image can be divided into smaller individual blocks containing data for decoding a 64 x 64 pixel block. See paragraph [0051].

From the citation above, one of ordinary skill would understand that Applicant's claimed embodiment does not store sub-images as described in the *Chui* publication. Namely, claim 5 recites that an enlarged image transmitting part receives an enlarged image from an enlarged image generating part and transmits the enlarged image to a portable terminal. Based on at least Applicant's claimed feature and the guidance provided in the *Chui* publication, it should be readily apparent that a *prima facie* case of anticipation has not been established.

Claims 13 and 14 recite features that are similar to those discussed above. Accordingly, Applicant believes that a *prima facie* case of obviousness has likewise not been established.

To properly anticipate a claim, the document must disclose, explicitly or implicitly, each and every feature recited in the claim. See Verdegall Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). For at least the foregoing reasons, withdrawal of the rejections to claims 5, 13, and 14 is respectfully requested.

Rejections under 35 U.S.C. §103

Claim 8 is rejected under 35 U.S.C. §103(a) for alleged unpatentability over the *Chui* publication in view of *Parulski et al* (U.S. Patent Publication No. 2003/0193603). Applicant respectfully traverses this rejection.

The PTO alleges that the *Chui* publication discloses every element recited in claim 8 except for a printing device and file stores imprinted by said printing device, as recited in the aforementioned claim. The PTO relies on the *Parulski* publication in an effort to remedy this deficiency.

Without acquiescing to the alleged teachings of the *Parulski* publication, however, Applicant respectfully submits that this reference fails to remedy the deficiencies of the *Chui* publication with respect to the combination of an enlarged image generating part and an enlarged image transmitting part as recited in Applicant's claim. At best, the combined teachings of the *Chui* and *Parulski* publications disclose and/or suggest sending an enlarged image to a climate machine based on image data that is previously stored in memory. See the *Chui*

publication, paragraph [0051]. As a result, a *prima facie* case of obviousness has not been established.

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, obviousness "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys. V. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). For at least the foregoing reasons, withdrawal of this rejection is respectfully requested.

Conclusion

Based on at least the foregoing amendments and remarks, Applicant submits that claims 5, 8, 13, and 14 are allowable, and this application is in condition for allowance. Accordingly, Applicant requests a favorable examination and consideration of the instant application. In the event any issues remain, the PTO is invited to contact the undersigned.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: September 23, 2008

By: _____



Shawn B. Cage
Registration No. 51522

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620